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*LIMITED TO MATTERS
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FEDERAL COURTS & AGENCIES
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July 25, 2001

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Commissioner for Patents
Washington, D.C. 20231

Re: U.S. Utility Patent Application
Appl. No. 09/518,383; Filed: March 3, 2000
For: **Human G-Protein Coupled Receptors**
Inventors: **LI et al.**
Our Ref: 1488.1220001/EKS/EJH
Art Unit: 1646

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Reply To Restriction Requirement; and
2. Return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

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The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036. A duplicate copy of this letter is enclosed.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Elizabeth J. Haanes, Ph.D.
Agent for Applicants
Registration No. 42,613

EKS/EJH
Enclosures

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

JUL 30 2001
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In re application of:

Li *et al.*

Appl. No. 09/518,383

Filed: March 3, 2000

For: **Human G Protein Coupled
Receptors**

Confirmation No.

Art Unit: 1646

Examiner: Basi, N.

Atty. Docket: 1488.12200001

Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the Office Action dated **June 29, 2001**, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group II, represented by claims 23-29, 31, 33-39, 41, 43-51, 53, 55-64, 66, 68-77, 79, 81-89, 91, 93-97, and 99. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made **with** traverse.

With respect to the Examiner's division of the claims into five groups and the reasons stated therefor, Applicants respectfully traverse. For example, Groups I and II are related as between an polynucleotide (Group II), a polypeptide encoded by the polynucleotide (Group I). Groups II and IV are related as between a host cell comprising a polynucleotide (Group II) and a method of using the host cell to screen for ligand binding (Group IV).

Even assuming, *arguendo*, that any of Groups I-V represent distinct or independent inventions, Applicants submit that to search and examine the subject matter



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of all the Groups together would not be a serious burden on the Examiner. For example, publications which disclose nucleic acids normally also disclose the amino acids encoded by the nucleic acids, thereby making it a simple matter for the Examiner to search and examine polypeptides encoded by claimed nucleic acids. Furthermore publications which disclose host cells comprising polynucleotides often disclose methods to use the host cells, thereby making it a simple matter for the Examiner to search and examine groups I-V together. The M.P.E.P. § 803 (Seventh Edition, Rev. July, 1998) states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Thus, in view of the M.P.E.P. § 803, Applicants respectfully request that all claims be searched and examined in the subject application. Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

However, while not acquiescing to the Examiner's restriction requirement, Applicants note that the claims of Group IV, *i.e.*, claims 30, 40, 52, 65, 78, 90, and 98, are related to the elected claims as between a product and a process for using the product, and further, that the process of claims 30, 40, 52, 65, 78, 90, and 98 depend from and include all the limitations of the product of claims from which they depend, *i.e.*, claims 29, 39, 51, 64, 77, 89, and 97, respectively. In light of the decisions in *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996), a notice was published in the Official Gazette which set forth

new guidelines for the treatment of product and process claims. *See* 1184 OG 86 (March 26, 1996). Specifically, the notice states that

in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim.

Id. Accordingly, if claims 29, 39, 51, 64, 77, 89, and 97 are found allowable, Applicants respectfully request that claims 30, 40, 52, 65, 78, 90, and 98 be rejoined and examined for patentability.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No.

19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Elizabeth J. Haanes, Ph.D.
Agent for Applicants
Registration No. 42,613

Date: July 26, 2001

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